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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,439	11/14/2003	Mark E. Dillon	E-2109-1	9370

7590 06/07/2005
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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,439

Applicant(s)

DILLON, MARK E.

Examiner

Christopher M. Keehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13-19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 13-19, and 21-27, drawn to a method of bonding, classified in class 427, subclass 387.
- II. Claims 9 and 20, drawn to a method of bonding, classified in class 427, subclass 394.
- III. Claims 10-12, drawn to a method of making a medical dressing, classified in class 424, subclass 402.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated. Group I is a method of bonding comprising applying a polysiloxane to a microporous substrate, while Group II is drawn to a method of bonding textiles.

Inventions of Group I and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated. Group I is a method of bonding comprising applying a polysiloxane to a microporous substrate, while

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Group III is drawn to a method of making a medical product by vulcanizing and applying pressure through a serpentine path. These are markedly different processes.

Inventions of Group II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated. Group II is drawn to a method of bonding textiles, while Group III is drawn to a method of making a medical product by vulcanizing and applying pressure through a serpentine path.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with John Earley on May 26 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8, 13-19, and 21-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-12 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claims 1-4, 6-8, 13-16, 18, 19, 21-24, 26 and 27 are objected to for the following reasons: these claims contain reference numbers pertaining to the drawings. These should be removed from the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5, 8, 17, 19, 25 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims contain the claim language "non-textile fabric" but this is not clear and is not defined in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 , 13-19 and 21-27 and are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant is claiming a one step process, but claims 1 and 13 appear to contain more than one step. If applicant intends to claim a one step curing method or single pass method, then this should be put in the claims. Further, claims 5, 8, 17, 19, 25 and 27 contain the claim language "non-textile fabric" but this is not clear. The definition of a textile is a fabric, so it is not clear how a non-textile fabric can be anything other than a fabric. Finally, in claim 21,

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applicant claims a "single-pass method", but it is not clear to what a single-pass method pertains.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 13, 15-17, 21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Zehnder (6,235,662 B1). Regarding claims 1, 3, 13, 15, 21 and 23, Zehnder discloses a process comprising casting a liquid polymer formulation as a coating onto a carrier substrate, applying a microporous polymer sheeting membrane, more specifically expanded polytetrafluoroethylene (PTFE), either applying a backing material to the distal surface of the impregnated membrane or applying a lamination of microporous polymer sheeting membrane and backing material to the surface coating, allowing or causing the liquid polymer layer to impregnate the microporous polymer membrane, and solidifying the liquid polymer formulation (col.3, lines 40-57). Regarding claim 21, there is no positive recitation of applying the claimed composite to a wound or scar, and because the same structure is present as taught by Zehnder, it appears that the composite of Zehnder could also act in the instantly claimed manner.

Regarding claims 4, 5, 16, 17, 24, and 25, Zehnder discloses a fabric (textile) backing (col.3, lines 55-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 7, 8, 14, 18, 19, 22, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zehnder (6,235,662 B1) in view of Dillon (4,832,009). Zehnder, as applied above, is as set forth and incorporated herein. Zehnder discloses adding silicones to the microporous substrate (col.3, line 8), but does not appear to specifically disclose polydimethylsiloxane. Dillon discloses applying polydimethylsiloxane to microporous expanded PTFE (col.3, lines 9-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the polydimethylsiloxane as taught by Dillon in the composite of Zehnder because Dillon teaches that using polydimethylsiloxane in expanded PTFE produces a waterproof device, which is desirable in Zehnder, resulting in a higher quality and more versatile product.

Claims 5, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zehnder (6,235,662 B1) in view of Cole (5,009,224). Zehnder, as applied above, is as set forth and incorporated herein. Zehnder does not appear to specifically disclose a

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foam backing. Cole discloses a typical wound dressing or bandage comprising a microporous substrate (col.7, lines 39-55) and that bandages with foam backings are known in the art to provide a thicker, more conformable, more cushioning material as compared to unfoamed backing (col.1, line 67-col.2, line 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a foam backing as taught by Cole in the composite of Zehnder because Cole teaches that using a foam backing produces bandages that are thicker, more conformable, more cushioning material as compared to unfoamed backing, resulting in a higher quality and more versatile product.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zehnder (6,235,662 B1) in view of Tse Tang (5,702,503). Zehnder, as applied above, is as set forth and incorporated herein. Zehnder does not appear to teach exposure to vacuum by means of a vacuum roller device as instantly claimed. Tse Tang discloses a microporous composite and applying a vacuum roller device to remove any residual water and solvents (col.14, lines 38-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a vacuum roller device as taught by Tse Tang to the composite of Zehnder because Tse Tang teaches that applying a vacuum device to a microporous composite removes residual water and solvents, which can therefore speed up processing times, such as curing, resulting in a more efficient process.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (571) 272-1087. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Keehan

June 2, 2005


DAVID J. BUTTNER
PRIMARY EXAMINER

